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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,581	09/24/2003	Robert W. Stuckel	252060	5637

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LEYDIG VOIT & MAYER, LTD  
TWO PRUDENTIAL PLAZA, SUITE 4900  
180 NORTH STETSON AVENUE  
CHICAGO, IL 60601-6731

EXAMINER
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HAMILTON, ISAAC N

ART UNIT	PAPER NUMBER
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3724

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/11/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/669,581

Applicant(s)

STUCKEL ET AL.

Examiner

Isaac N. Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 1-21 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-26 and 29-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01/16/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The rejection made under 35 USC 112 is hereby withdrawn.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 22, 30 and 31 are rejected under 35 U.S.C. 102(a) as being anticipated by Christen et al (US 2002/0046635 A1), hereafter Christen. Christen discloses a method for cutting a financial card in paragraphs [0014]-[0016]; first configuration having a first periphery 10; second configuration having a second periphery 17; supplying a succession of discrete, individual financial cards 10 to the cutting station 8, 9, 12, 13 as disclosed in paragraph [0014]; cutting each financial card 10 in succession to form an individual cut financial card 17 and corresponding scrap, each cut financial card 17 being of the second configuration having the second periphery; element 10 becomes scrap after cutting; cut financial cards 17 are transported away from the cutting station, separately from the scrap, along passage 16 to delivery station 3, 4, 6; credit cards in paragraph [0004], line 1; element 12 is a cylindrical punching tool which punches a hole in the card having the first configuration 10; the scrap corresponding to each cut financial card is intrinsically discarded in succession. Note that the term discarded has been interpreted as merely being transported to another location, i.e. the trash, recycle bin, the floor.

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4. Claim 32 is rejected under 35 U.S.C. 102(b) as being anticipated by Bonomi (5,080,748). Bonomi discloses financial card with a first configuration having a first periphery 20; a second configuration having a second periphery 65; supplying the financial card having said first configuration and a functional magnetic stripe 36 to a cutting station in column 5, lines 24-29 and 60-63; cutting the financial card at the cutting station to form a cut financial card being of the second configuration having the second periphery such that at least a portion of the magnetic stripe remains on the card as recited in column 5, lines 24-29 and 60-63; transporting the cut financial card away from the cutting station is inherent because the card is then sent to customers for regular usage; the portion of the magnetic stripe remaining on the cut card is inherently still functional following the cutting step because the credit card has to work for the customer who receives the credit card.

5. Claim 32 is rejected under 35 U.S.C. 102(b) as being anticipated by the standard method of disposing of unwanted credit cards. For example, the Examiner has disposed of unwanted cards by using a scissors and cutting the unwanted credit card in half perpendicular to the magnetic stripe more than five years ago. This method of disposing of unwanted credit cards anticipates the method for cutting a financial card from a first configuration having a first periphery to a second configuration having a second periphery, wherein the unwanted and uncut credit card is a financial card with a first configuration having a first periphery, and the left half of the financial card after the card is cut with the scissors is a financial card having a second configuration with a second periphery; supplying the financial card having said first configuration and a functional magnetic stripe to a cutting station is anticipated by the step of removing the credit card from my wallet and placing it in between the blades of the scissors;

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cutting the financial card at the cutting station to form a cut financial card being of the second configuration having the second periphery such that at least a portion of the magnetic stripe remains on the card is anticipated by operating the scissors to cut the credit card in half, wherein both halves of the credit card have a second configuration with a second periphery and a magnetic stripe; transporting the cut financial card away from the cutting station is anticipated by throwing the halves of the cut credit card into the trash; the portion of the magnetic stripe remaining on the cut card is still functional following the cutting step is anticipated by the cut halves of the credit cards still having magnetic strips that are capable of being swiped through credit card transaction machines.

6. Claim 32 is rejected under 35 U.S.C. 102(a) as being anticipated by Pentz (D462,965). Pentz discloses a method for cutting a financial card from a first configuration having a first periphery to a second configuration having a second periphery; supplying the financial card having said first configuration and a functional magnetic stripe to a cutting station; cutting the financial card at the cutting station to form a cut financial card being of the second configuration having the second periphery such that at least a portion of the magnetic stripe remains on the card; transporting the cut financial card away from the cutting station; the portion of the magnetic stripe remaining on the cut card is still functional following the cutting step. The cut financial card having a second configuration and a second periphery is shown in the figures. The hole in the card was intrinsically punched into the card at a cutting station. Before the hole was punched into the financial card in the figures, the financial card had a first configuration having a first periphery, wherein the first periphery is the outside edges of the card, and the second periphery is the edges produced by the punched out hole. The card in the figures still has a

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functioning magnetic stripe because the hole punched in the card did not affect the magnetic stripe as shown. Supplying and transporting the financial card to and from a cutting station is inherent because the card has to be manufactured before the punching station, and the card is then sent to customers for regular usage.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Christen in view of Kline et al (2,430,720), hereafter Kline. Christen discloses everything as noted above, but does not disclose a first conveyor that has a plurality of spaced nests. However, Kline teaches first conveyor in figure 2 that has a plurality of spaced nests 26. It would have been obvious to provide a first conveyor that has a plurality of spaced nests in Christen as taught by Kline in order to automate the process of supplying cards to the cutting station.

9. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Christen and Kline as applied to claim 23 above, and further in view of Roy et al (5,586,479), hereafter Roy. The combination discloses everything as noted above, but does not disclose a magnetic stripe reader. However, Roy teaches magnetic stripe reader 58A, 58B in column 4, lines 30-68. It would have been obvious to provide a magnetic stripe reader in the combination as taught by Roy in order to determine the amount of skew of the cards.

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10. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Christen and Kline as applied to claims 23 above, and further in view of Roy. The combination discloses everything as noted above, but does not disclose properly locating the card with a cutting device. However, Roy teaches properly locating the card with a cutting device in column 5, lines 19-42. It would have been obvious to provide a method of properly locating the card with a cutting device in the combination as taught by Roy in order to ensure proper cutting of a skewed card.

11. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Christen as applied to claims 22, 30 and 31 above, and further in view of Pentz (D462,965). The combination discloses everything as noted above, but does not disclose a non-conventional configuration of a smaller rectangular shape. However, Pentz teaches non-conventional configuration of a smaller rectangular shape in the figures. It would have been obvious to provide a non-conventional configuration of a smaller rectangular shape in Christen as taught by Pentz in order to allow a user to fit the card into rectangular wallet pockets.

### ***Response to Arguments***

Applicant's arguments filed 12/26/06 have been fully considered but they are not persuasive. Applicant asserts that Christen does not disclose supplying a succession of cards for cutting at a cutting station. Although Christen cuts several cut financial cards 17 out of the financial card 10, the limitation of "cutting, at said cutting station, each card in succession to form an individual cut financial card" is satisfied by the first cut financial card 17 that is cut out of each financial card 10. The limitations do not preclude a user from cutting out several cut financial cards 17 from financial card 10.

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Applicant also asserts that Christen does not disclose that scrap is created corresponding to an individual cut financial card, or that the scrap corresponding to each cut financial card. However, in figure 1 after cut financial card 17 is cut out of the financial card 10, the rest of the card 10 is considered to be scrap despite any portion of card 10 being reused for other cards. Moreover, due to the fact that there is only one card 10 on elements 8 and 9, it is implied that the cards 10 that have been punched and used-up have been discarded. If the used-up card 10 was not discarded, then figure 1 would have piles of used-up cards 10 on elements 8 and 9.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac Hamilton whose telephone number is 571-272-4509. The examiner can normally be reached on Monday through Friday between 8am and 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



IH  
March 30, 2007



KENNETH E. PETERSON  
PRIMARY EXAMINER